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JUN 02 2004

OFFICE OF PETITIONS

In re Application of: :
Donald E. Weder :
Application No.: 09/764,365 :
Filed: January 18, 2001 :
For: OPTICAL EFFECT MATERIAL AND :
METHODS :

**DECISION TERMINATING
PROCEEDINGS**

This is a decision terminating proceedings in the above-identified reissue application in view of the expiration of U.S. Patent No. 5,861,199.

The above-identified application is a reissue application of U.S. Patent No. 5,861,199 (issued on January 19, 1999), which patent resulted from application No. 08/717,469, filed on September 20, 1996. As filed on September 20, 1996, the first sentence of the specification of application No. 08/717,469 refers to (*inter alia*¹) application No. 06/613,080, filed on May 22, 1984.

Section 251 of title 35, United States Code, first paragraph, provides that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

¹ The specification of application No. 08/717,469 also refers to other prior-filed applications. Application No. 06/613,080, filed May 22, 1984, is the earliest filed application to which application No. 08/717,469 refers.

Sections 154(a)(2) and (a)(3) of title 35, United States Code, provide that:

(2) TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

(3) PRIORITY.—Priority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent.

This first sentence of the specification of application No. 08/717,469 contains a specific reference under 35 U.S.C. § 120² to (*inter alia*) application No. 06/613,080, filed May 22, 1984. Cf. Abbott Lab. v. Novopharm Ltd., 104 F.3d 1305, 1309, 41 USPQ2d 1535, 1537 (Fed. Cir. 1997) (the statement that an application is a divisional application of a prior-filed application is a specific reference to the prior-filed application in accordance with 35 U.S.C. § 120 for purposes of 35 U.S.C. § 154(a)(2), regardless of whether the divisional application actually received any benefit from the prior-filed application). Therefore, the term of U.S. Patent No. 5,861,199 is measured from the filing date of application No. 06/613,080, namely May 22, 1984. See *id.* At 1309, 41 USPQ2d at 1537; see also Changes to Implement 20-Year Patent Term and Provisional Applications, 60 Fed. Reg. 20195, 20205 (Apr. 25, 1995) (response to comment 5³). Accordingly, U.S. Patent No. 5,861,199 expired on May 23, 2004.⁴

² In addition, the declaration under 37 CFR 1.63 filed in application No. 08/717,469 on September 20, 1996 also states that applicant claims the benefit under 35 U.S.C. § 120 of (*inter alia*) application No. 06/613,080, filed May 22, 1984.

³ The response to comment 5 states:

Under 35 U.S.C. § 154(a)(2), if an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. § 120, 121 or 365(a), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. § 120, 121 or 365(a). For a CIP application, applicant should review whether any claim in the patent that will issue is supported in an earlier application. If not, applicant should consider canceling the reference to the earlier filed application.

⁴ While May 22, 2004 was a Saturday, the provisions of 35 U.S.C. § 21(b) do not operate to extend the expiration date of a patent. Cf. MPEP 2506 (the provisions of 35 U.S.C. § 21(b) will operate to extend the period for payment of a maintenance fee if the last day for payment

As indicated by the U.S. Court of Appeals for the Federal Circuit: “[t]he language of [35 U.S.C. §] 251 is unambiguous: the [Director] has authority to reissue a patent only ‘for the unexpired term of the original patent.’” See In re Morgan, 990 F.2d 1230, 1231, 26 USPQ2d 1392, 1393 (Fed. Cir. 1993) (quoting 35 U.S.C. § 251, ¶ 1). Therefore, assuming (*arguendo*) that the conditions of 35 U.S.C. § 251 were otherwise satisfied, the Director had the authority to reissue U.S. Patent No. 5,861,199 only for a term that expired on May 23, 2004. See 35 U.S.C. § 251, ¶ 1 (“the Director shall . . . reissue the patent . . . for the unexpired part of the term of the original patent”); see also Questions and Answers Regarding the GATT Uruguay Round and NAFTA Changes to U.S. Patent Law and Practice at 8 (June 1995) (answer to question 4⁵). Put simply, even if the Office did reissue U.S. Patent No. 5,861,199 with a disclaimer of any or all of the benefit claims under 35 U.S.C. § 120 in U.S. Patent No. 5,861,199, such a reissue patent would have expired on May 23, 2004 by operation of law (35 U.S.C. § 251, ¶ 1) because a reissue patent is limited to “the unexpired part of the term of the original patent.” See 35 U.S.C. § 251, ¶ 1.

Since U.S. Patent No. 5,861,199 is now an expired patent, the Director no longer has authority under 35 U.S.C. § 251 to reissue U.S. Patent No. 5,861,199. See Morgan, 990 F.2d at 1231, 26 USPQ2d at 1393.

Accordingly, the proceedings in the above-identified reissue application are hereby **terminated**. See Morgan, 990 F.2d at 1232, 26 USPQ2d at 1393 (while 35 U.S.C. § 251 does not expressly require termination of a reissue proceeding when a patent expires, that is an inevitable concomitant of the provision that the patent can no longer be reissued).

This decision is **not** final agency action within the meaning of 5 U.S.C. § 704. Any request for further review of this matter must be by way of a petition under 37 CFR 1.181(a)(3) filed within **TWO (2) MONTHS** from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b).

falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, but will not operate to extend the expiration date of a patent if the maintenance fee is not timely paid).

⁵ Question: Can a patentee disclaim/claim the benefit of the filing date of an earlier filed application after the patent issues?

Answer: Yes, so long as the conditions of 35 U.S.C. § 251 are satisfied. Note that a disclaimer will not, however, operate to extend the term of a patent as the term of a reissued patent is limited by the unexpired term of the original patent.

Further correspondence with respect to this matter should be addressed as follows:

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Post Office Box 1450
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Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8850.

Since proceedings in the above-identified reissue application are hereby terminated, Technology Center 1700 will process the above-identified application as an abandoned application.

A handwritten signature in black ink, appearing to read 'RWB', is positioned above the printed name of Robert W. Bahr.

Robert W. Bahr
Senior Patent Attorney
Office of the Deputy Commissioner
for Patent Examination Policy